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PatentREMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-24 are pending in the application. Claims 1, 10, 17 and 20 have been amended. The amendment is fully supported by the original disclosure. No new matter has been introduced.

Claim rejections – 35 USC §102

Claims 17, 18, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakamura (U.S. Patent No. 6,891,328).

Assignee respectfully submits that Nakamura does not disclose all of the elements of independent claim 20. The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any conclusion of anticipation includes that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.
(See MPEP § 2131.01.)

For example, Examiner has not established that Nakamura discloses "*passing the image through a light transparent slot comprising a non-uniform width*", as recited in claim 20. In the Office Action the Examiner has asserted that:

Upon further review, the Examiner would like to point Applicant's attention to Fig. 7A which is a more detailed view of a light transparent slot. (See page 2 of the Office Action.)

However, Assignee submits that the Examiner has failed to establish that Nakamura teaches any form of a "*slot*", as recited in claim 20. Conversely, at column 3, lines 64-65, FIG. 7 of

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Nakamura is described as "a view showing a light source with leads provided in the periphery of a transparent electrode layer". Likewise, at column 3, lines 49-51, FIG. 2 of Nakamura is described as a "top view of a light source in which the width of the electroluminescence layer increases gradually from the connecting point." Likewise, at column 3, lines 52-54, FIG. 3 of Nakamura is described as a "top view of a light source with connecting points provided on both sides of an electroluminescence layer." Accordingly, Assignee submits that the Examiner has failed to point to any specific portion of Nakamura that correlates with "*a light transparent slot*", as claimed. Second, Assignee submits that the Examiner has failed to establish that Nakamura teaches passing "the image through a light transparent slot", as recited in claim 20. Here, claim 20 recites "*illuminating a document to generate an image*" in addition to "*passing the image through a light transparent slot comprising a non-uniform width*", and Assignee can find no explanation by the Examiner establishing how the "light source" of FIGS. 2, 3, and 7 of Nakamura is capable of "passing an image" in addition to operating as a light source. In the absence of the Examiner pointing to such a disclosure in Nakamura, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that Nakamura discloses the identical invention as is required for anticipation. See MPEP § 2131.

Likewise, claims 17, 18, and 21 distinguish from Nakamura on at least the same or similar basis as claim 20.

Claim rejections – 35 USC §103

Claims 1, 5-8, 10, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura et al. (U.S. Patent No. 6,891,328) of Applicant's admitted prior art (APA). Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura '328

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in view of APA and further in view of Onda et al (U.S. 6,404,515). Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura '328 in view of Onda et al '515. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakamura '328 in view of Gubela (U.S. 3,973,342).

Regarding claim 1, the proposed combination does not teach or suggest the limitation of independent claim 1 reciting "*a light transparent slot comprising a substantially bar form shape, wherein two or more widths corresponding to two or more points along a longitudinal direction of the light transparent slot are not all the same ... and wherein the light transparent slot is located along an image path between the light source and the lens assembly*". The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any *prima facie* conclusion of obviousness includes that:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03.

In the Office Action, the Examiner argues:

Nakamura discloses a case comprising a light transparent slot comprising a substantially bar form shape, wherein two or more widths corresponding to two or more points along a longitudinal direction of the light transparent slot are not all the same (Figs 2A-3B, 7A). (See pages 2-3 of the Office Action.)

The Examiner goes on to assert that a combination of APA with Nakamura cures a failure of Nakamura to disclose a light source, arguing:

Nakamura does not disclose expressly a light source capable of illuminating a document ... APA discloses a light source 120 illuminating the document ... (See page 3 of the Office Action.)

Assignee cannot agree. First, as argued above with respect to the §102 rejection, the Examiner has failed to establish how the "light source 5" of FIGS. 2, 3, and 7 of Nakamura is capable of operating as a "light transparent slot" in addition to operating as a light source. Second,

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Assignee submits that even assuming for the sake of argument that Nakamura and APA were combined, the Examiner has failed to establish why one of ordinary skill in the art would modify the slot 112 of APA instead of replacing the "light source 120" of APA with the "light source 5" of Nakamura. Additionally, Assignee cautions the Examiner against attempting to cure Nakamura by combination with Onda. Specifically, Assignee submits that the Examiner has not established that Nakamura and/or Onda alone or in combination teach or suggest the limitation of independent claim 1 reciting "*wherein the light transparent slot is located along an image path between the light source and the lens assembly*". In the absence of the Examiner pointing to such a disclosure in the proposed combination, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that the proposed combination renders obvious all of the features of claim 1.

Likewise, claims 5-8, 10, and 14-16 are similarly not obvious, at least on the same or similar basis as claim 1.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

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Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,
Attorney for Assignee

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